Paper No. 23
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Orbital Sciences Corp.

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Serial No. 74/294,643

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Harold E. Meier of Baker & Botts, L.L.P., for Orbital Sciences Corp.

Henry S. Zak, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

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Before Cissel, Hanak and Rogers, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 16, 1992, applicant's predecessor in interest applied to register the mark "SMARTTRACK" for what were subsequently identified by amendment as "vehicle tracking and information systems; namely, computer software for tracking vehicles and processing GPS position information regarding the location and status of such vehicles; monitors for displaying vehicle location information; and

communications equipment namely transmitters and receivers for relaying vehicle location information between dispatchers and vehicle operators," in Class 9. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these services.

Registration was refused under Section 2(d) of the Act because the Examining Attorney determined that applicant's mark, if it were used in connection with the goods specified in the application, would so resemble the mark "SMART TRAX," which is registered[1] for "truck transport services," in Class 39, and "computerized satellite tracing of vehicles and shipments of goods shipped by truck or air," in Class 35, that confusion would be likely.

In support of his refusal to register, the Examining Attorney made of record a dictionary definition of the word "trace" which shows that it is almost synonymous with the word "track." Additionally, the Examining Attorney submitted excerpts retrieved from a search of the term "vehicle tracking" in two different Internet databases, AltaVista and Yahoo. Not surprisingly, articles and advertisements for firms providing the service of vehicle

[1] Reg. No. 2,080,434 issued to TNT Canada Inc., a Canadian Corporation, on July 22, 1997, but the priority date for the

registration and the filing date of that application both predate the filing of the instant application.

tracking were located under this topic, as were articles and advertisements for companies which sell the computer and telecommunication equipment which is used in rendering the service of tracking vehicles. Contrary to the contention of the Examining Attorney, however, it is not at all clear from this evidence that any one company provides both the equipment used to track vehicles and the service of tracking vehicles, much less that one business does both under a single mark. In a similar sense, excerpts the Examining Attorney retrieved from the DIALOG database do not clearly establish that one may buy computerized vehicle tracking and communications equipment from the same company which renders vehicle tracking services, much less that the same mark is used to identify both the service and the equipment used in rendering the service.

When the refusal to register was made final, applicant appealed. Both the applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing before the Board.

Based on careful consideration of the record and arguments before us, we hold that the refusal to register is not sufficiently supported in this case.

Both applicant and the Examining Attorney agree that the test for resolving the issue of whether confusion is

likely is set forth in In re E. I. DuPont de Nemours & Co., 476 F.2d 1357, USPQ 563 (CCPA 1973). The Examining Attorney's application of this test leads him to conclude that the marks "are highly similar, if not identical," and that the evidence of record "clearly shows that not only may the same companies offer both GPS tracking software products and services," but also that "purchasers of the respective goods and services are not mutually exclusive because they are exposed simultaneously to articles and advertisements for both GPS positioning goods and services."

Applicant argues that the registered mark is diluted, that the marks of applicant and registrant differ with regard to appearance and pronunciation, and that, in connection with the respective goods and services here at issue, they create different commercial impressions. Additionally, applicant concedes that registrant "provides a vehicle tracking service," but argues that "the mere fact that both parties' goods/services have something to do with computers and vehicle tracking is not sufficient to support a finding that confusion is likely to occur, given that the classes of purchasers of Applicant's goods and Registrant's services are mutually exclusive."

Applicant's arguments with respect to the asserted dissimilarity between its mark and the registered mark are not well taken. Although there are subtle distinctions between these marks in appearance, they are similar because they use similar terminology and have similar, suggestive connotations in connection with the goods set forth in the application and the services specified in the cited registration. These marks create similar commercial impressions. Plainly, if the goods and services as specified in the application and cited registration, respectively, were closely related in the commercial sense, the use of these two similar marks in connection with them would be likely to cause confusion.

Applicant concedes that its goods are related to the services set forth in the cited registration in the sense that purchasers of its tracking software and hardware may include providers of vehicle tracking services. As noted above, however, applicant contends that the purchasers of its goods are mutually exclusive from the purchasers of the services set forth in the registration.

The Examining Attorney had the burden of establishing not just that the marks are similar, but also that applicant's goods are commercially related to the services specified in the registration in such a way that confusion

would be likely if applicant were to use its mark on the goods set forth in the application. As we pointed out above, however, the evidence submitted by the Examining Attorney does not clearly demonstrate a basis upon which we can conclude that potential purchasers of applicant's vehicle tracking computer software, hardware and communications equipment are also prospective customers for the services of tracking vehicles. To the contrary, reason would lead us to adopt applicant's contention that whereas applicant's software and hardware will be purchased by businesses which use such equipment to track vehicles, businesses using this equipment to track vehicles are not themselves potential purchasers of vehicle tracking services. The record in this application contains nothing to the contrary.

Contrary to the arguments of the Examining Attorney, the database listing, under the heading of "vehicle tracking," of both vehicle tracking services and various items of equipment used to track vehicles, does not demonstrate that the services are promoted to the same customers to whom the equipment is sold. "Vehicle tracking" is just a heading under which both the services and the goods naturally fall. The evidence does not

establish that the respective goods and services of applicant and registrant move through common trade channels, that both would be marketed under a single mark, or that both would be purchased by a single entity.

The record therefore does not show that confusion with the registered mark would be likely if applicant were to use its mark in connection with the goods set forth in this application. Accordingly, the refusal to register is reversed.

R. F. Cissel

E. W. Hanak

G. F. Rogers
Administrative Trademark Judges
Trademark Trial & Appeal Board